Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES T. MERRILL and JAMES R. BULTER

Appeal No. 2001-1829
Application No. 09/329,502

ON BRIEF

Before KIMLIN, OWENS and KRATZ, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request a rehearing of our decision mailed on September 30, 2002 wherein we affirmed the decision of the examiner to reject claims 1-6, 8 and 9 under 35 U.S.C. § 103 as being unpatentable over West in view of admitted prior art as disclosed by appellants in their specification; to reject claims 10-13 and 18-20 under 35 U.S.C. § 103 as being unpatentable over West in view of admitted prior art as disclosed by appellants in their specification and Butler; and to reject claims 1-6, 8-13 and 15-21

under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,955,642 in view of West.

In our decision mailed on September 30, 2002, we accepted the examiner's determination (answer, pages 1 and 2) that the terminal disclaimer submitted with the brief was not signed by a person having apparent authority to do so and that the appealed claims remained properly rejected and unpatentable under the judicially created doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 5,955,642 in view of West. This was so since appellants' reply brief did not contest that determination of the examiner as set forth in the answer.

Appellants now argue, in effect, that a power of attorney previously filed on July 16, 1999 causes the examiner's criticism of the terminal disclaimer submitted with the brief to be in error on the record of this application.

The power of attorney paper filed on July 16, 1999 has been located and secured in the application file jacket. Appellants appear to be correct at least in so far as the examiner's criticism in the answer does not, on the face thereof, appear to have taken the power of attorney filed on July 16, 1999 into account in considering the propriety of the terminal disclaimer.

In order to remedy this apparent deficiency in the examiner's consideration of the terminal disclaimer on the record of this application, it is appropriate that we remand the application to the examiner.

In light of the need for such a remand as highlighted above, we take the following course of action.

Our earlier decision of September 30, 2002 in this appeal is hereby VACATED.

In so doing, we are mindful of our affirmance of the examiner's § 103 rejections in the decision of September 30, 2002 and appellants' continuing contrary viewpoint reexpressed in the Request regarding that affirmance. However, in view of the need for a remand of this application for the examiner to reconsider the terminal disclaimer and obviousness-type double patenting rejection, it is appropriate that our previous final decision as to the examiner's § 103 rejections be held in abeyance by vacating the September 30, 2002 decision in its entirety to facilitate the procedural handling of this application by the examiner and appellants.[1] See 37 CFR 1.196(e).

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[1] We emphasize that this remand and vacation of decision should not be understood as indicating that we have now determined that the examiner's rejections, which we had sustained in the vacated earlier decision, are in error.

As such, any further consideration of appellants' Request by this panel of the Board is not appropriate at this time and will be held in abeyance pending a return of the application to us for entry of a final decision on any rejections maintained by the examiner.

On remand, the examiner should reconsider whether or not the terminal disclaimer furnished by appellants with the brief is effective to rebut the obviousness-type double patenting rejection giving due consideration to the power of attorney filed on July 19, 1999.

If after such reconsideration, the examiner adheres to any or all of the rejections, of record, we expressly authorize the examiner to file a supplemental answer in accordance with the provisions of 37 CFR § 1.193(b)(1) in returning the application to us for a final decision. The supplemental answer should include the examiner's complete position with respect to those rejections adhered to, including a full statement of the rejections and the examiner's complete response to the arguments. This will also afford the examiner an opportunity to address appellants' arguments traversing the § 103 rejections as emphasized in the reply brief.

SUMMARY

We have granted appellants' Request to the extent that the application is being returned to the examiner so as to ensure that the examiner has fully considered the present record in maintaining the rejections that were forwarded to us for review on appeal.

In that regard, we vacated our earlier decision to allow for that remand of the application to the examiner primarily so that the examiner could reconsider the obviousness-type double patenting rejection giving due effect to a previously filed power of attorney (Paper No. 2) and a terminal disclaimer filed with the brief.

We have authorized the examiner to file a supplemental answer.

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01(D)(8th ed., Aug. 2001). It is important that the Board be promptly informed of any action affecting the appeal in this case.

VACATED AND REMANDED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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TERRY J. OWENS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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PETER F. KRATZ)
Administrative Patent Judge)

FINA TECHNOLOGY INC
P.O. BOX 674412
HOUSTON, TX 77267-4412